

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-24 are pending in the application, with claims 1, 7, 13 and 19 being the independent claims. Claim 1 has been amended for clarification. New dependent claims 25-28 are added. The changes are believed to introduce no new matter nor raise any new issues, and their entry is respectfully requested. Based on the above amendments and the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and that they be withdrawn.

35 U.S.C. § 102

The Examiner rejected claims 1-2, 7-8, 13-14 and 19-20 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Publication No. 2001/0032137 to Bennett et al. ("Bennett").

Bennett relates to an information distribution and redemption system for creating and sending personalized e-mail messages. The Examiner asserts that Bennett discloses, among other features, a method for providing different combinations of multiple pieces of content in a single e-mail to a plurality of patrons. The excerpts of Bennett the Examiner relies upon as well as the remainder of the reference, however, fail to disclose all features of independent claims 1, 7, 13 and 19.

Paragraphs 0008 and 0009 describe generally that using the Bennett system, e-mail can be targeted to an interested subset of a merchant's patrons. For example, a pet store could send an e-mail regarding cat food to cat owners and a different e-mail regarding dog food to dog owners. See paragraph 0009. This, however, is precisely the type of prior art method specifically acknowledged in the present specification and improved upon. Specification, p. 2, l.

2 – p. 3, l. 1. In contrast, in an analogous situation using the present invention, multiple pieces of content such as cat food content and dog food content could be combined into a single e-mail and transmitted to those patrons known to own at least one cat and dog. Available advantages to such a system and method will be discussed below.

Continuing with the portions of Bennett the Examiner relies upon, paragraph 0012 notes that an information clearinghouse, a type of customer database, is used with the invention. Paragraphs 0034-0036 relate to further details about the customer database and an enrollment process. Paragraph 0042 provides still additional information about the database. Paragraphs 0066-0069 include disclosure regarding collecting information about a patron's interests and making offers to the patron based on those interests. See paragraph 0068. Paragraph 0073 describes focusing offers to establish beneficial relationships. Paragraph 0074 discusses that two merchants may cooperate in a communication to a patron. As an example, the clearinghouse 24 "can propose to a carry out restaurant that it provide information or a promotional offer ... suggesting the advantage of having both a movie and dinner." Thus, it appears that any such offer would occur in a form as provided to the clearinghouse 24, rather than be generated by the system. That is, there is no suggestion that the clearinghouse generates this offer by combining multiple pieces of content.

Paragraphs 0077-0082 further describe customizing and personalizing, and merging various information to create a desired communication. The merged information here, however, appears to merely be patron and merchant information. Paragraph 0078. In particular, this disclosure does not describe combining multiple pieces of content, e.g., multiple "campaigns" in the language of Bennett. Paragraphs 0086-0088 describe creating a personalized e-mail

matching a patron with *a campaign*. Thus, Bennett appears to be concerned with directing a single campaign to the appropriate patrons, not for example combining multiple campaigns into a single e-mail. Finally, paragraph 0091 describes an alternative embodiment in which campaigns are similarly matched with a subset of patrons. Applicants note, that contrary to the Examiner's assertion regarding lines 27-35 in paragraph 0091, the disclosure in Bennett relates to a "prioritized queue" with respect to when a message is sent, but provides no suggestion with respect to prioritizing content for placement in an e-mail, as claimed.

Applicants have found that the feature of combining select multiple pieces of content into a single e-mail to be sent to a select individual, optionally in combination with other claimed features such as limiting and/or prioritizing the content, can lead to improved success in achieving a positive response to such e-mails. The invention can allow, among other advantages, the transmission of a fewer number of e-mails that contain a limited amount of offer content determined to be of most interest to the individuals receiving them.

For at least the above reasons, Bennett fails to disclose or suggest all features of independent claims 1, 7, 13 and 19 or their respective dependent claims. Applicants respectfully request that the Examiner withdraw this rejection and that all claims be allowed.

35 U.S.C. § 103(a)

The Examiner rejected remaining claims 3-6, 9-12, 15-18 and 21-24 under 35 U.S.C. § 103(a) as allegedly being obvious in view of various combinations of Bennett, U.S. Patent No. 4,723,212 to Mindrum ("Mindrum") and U.S. Patent No. 6,076,101 to Kamakura ("Kamakura").

Specifically, the Examiner asserts that claims 3-4, 9-10, 15-16 and 21-22 are unpatentable over Bennett in view of Mindrum.

As a preliminary matter, Bennett fails to disclose all features of the pending independent claims, from which claims 3-4, 9-10, 15-16 and 21-22 depend, as has been demonstrated above. The disclosure in Mindrum does nothing to compensate for the illustrated deficiencies of Bennett, and these claims are therefore allowable for at least that reason.

With respect to Mindrum, the Examiner admits that Bennett further fails to disclose limiting the number of pieces of content to be provided in an e-mail. The Examiner seeks to rely upon Mindrum to remedy this deficiency. Mindrum, however, relates to an apparatus for printing coupons at a checkout terminal in a store. This is an entirely different field of invention than that of the present invention, and limiting the number of coupons printed during checkout bears no relation to nor provides any motivation with respect to limiting the amount of content in an e-mail message. Applicant respectfully requests that the Examiner reconsider this rejection and that it be withdrawn.

The Examiner also asserts that claims 5, 11, 17 and 23 are unpatentable over Bennett in view of Kamakura and claims 6, 12, 18 and 24 are unpatentable over Bennett in view of Kamakura and Mindrum.

Again, however, neither Bennett nor Mindrum, alone or in combination, discloses or suggests all features of the pending independent claims, from which claims 5, 6, 11, 12, 17, 18, 23 and 24 depend, as has been demonstrated above. The disclosure in Kamakura does nothing to compensate for the illustrated deficiencies of Bennett and Mindrum, and these claims are therefore allowable for at least that reason.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,



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